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Cindy Chickaro

DATE:

February 4, 2002

**PATENT
BOX AF**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Reissue Patent Application of : Group Art Unit: 3617
Robert H. Staat :
Conf. No. 4290 :
Appln. No.: 08/999,730 : Examiner: S. Morano
Filed: December 24, 1997 : Attorney Docket
For U.S. : No. 7311-24RE
Patent No.: 5,509,546 : (207311.0060)
Granted: April 23, 1996 :
For: MAGNETICALLY-ACTUATED :
COUPLER FOR MODEL RAILROAD :
CARS :
RECEIVED :
MAY 11 1998 :
GRANTED :
RECEIVED :
MAY 11 1998 :

Commissioner for Patents
Washington, DC 20231

ATTENTION: Board of Patent Appeals and Interferences

APPELLANT'S BRIEF (37 C.F.R. § 1.192)

This brief is in furtherance of the Notice of Appeal, filed in this application on December 3, 2001.

The fees required under § 1.17 are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF

This brief is transmitted in triplicate. (37 C.F.R. § 1.192(a)).

This brief contains these items under the following headings, and in the order set forth below (37 C.F.R. § 1.192(c)).

L. REAL PARTY OF INTEREST

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APPLICATION 08/292,880

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I. REAL PARTY OF INTEREST (37 C.F.R. § 1.192(c)(1))

The real party in interest in this appeal is Bachman Industries, Inc., assignee of U.S. Patent 5,509,546.

II. RELATED APPEALS AND INTERFERENCES (37 C.F.R. § 1.192(c)(2))

There are no appeals or interferences that will directly affect, or be directly affected by, or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS (37 C.F.R. § 1.192(c)(3))

The status of the claims in this application are as follows:

A. TOTAL NUMBER OF CLAIMS IN APPLICATION

Claims in the application are: 34 claims. (Claims 1-34)

Claims currently pending in the application: 33. (Claims 2-34)

B. STATUS OF ALL THE CLAIMS

1. Claims cancelled: 1
2. Claims withdrawn from consideration but not cancelled: NONE
3. Claims pending: 2-34
4. Claims allowed: 2-8, 22-34
5. Claims rejected: 9-21

C. CLAIMS ON APPEAL

The claims on appeal are: 9-21

IV. STATUS OF AMENDMENTS (37 C.F.R. § 1.192(c)(4))

An Amendment After Final was filed on January 2, 2002 and refiled on January 11, 2002 in corrected format adding claims 22-34. The Examiner has indicated in an Advisory Action mailed January 23, 2002 that claims 22-34 will be entered and allowed pending resolution of this appeal.

V. SUMMARY OF THE INVENTION (37 C.F.R. § 1.192(c)(5))

The following summary is provided without any intention to limit the scope of the claims. (All references are to the present application.)

Independent claim 9 is directed to a magnetically-actuated coupler assembly (10) for a model railroad car (Fig. 1 and col. 2, lines 59-62). The claimed assembly comprises a drawbar (12) capable of being pivotally mounted within the coupler pocket (20) of a model railroad car. The drawbar includes a first end (14) having an integrally formed leaf spring (18), a coupler head (22) on a second end (16) and an integrally formed cantilever spring (24) extending from the drawbar adjacent the coupler head. The assembly further includes a coupler knuckle (26) and a magnetically-actuated post (28) pivotally securing the coupler knuckle (26) to the coupler head (24). Finally, the coupler head (24) contains a pair of stops (40, 42) which limit the movement of the pivotally mounted coupler knuckle (Col. 3, lines 29-32).

Independent claim 10 is also directed to a magnetically-actuated coupler assembly and includes substantially each of the elements identified above in claim 9 except the requirement for a leaf spring (19). A leaf spring is separately set forth in dependent claim 11.

Dependent claim 12 calls for the outer tip of the coupler knuckle to contain a lip (50) (like claim 3).

Dependent claim 13 calls for the drawbar to include an extension lip (48) (like claim 4).

Dependent claim 14 calls for the coupler knuckle to contain a slot, an edge (44) of which interacts with one of the stops of the coupler head (like claim 5).

Dependent claim 15 calls for the cantilever spring and drawbar to be molded together as a unitary piece from engineering plastic (Col. 3, lines 58-60).

Independent claim 16 is similar in construction to independent claim 10 but substitutes in place of the cantilever spring set forth in claim 10, a magnetically-actuated post (18) pivotally securing the coupler knuckle to the coupler head.

Claims 17 through 21 depend from independent claim 16 essentially parallel dependent claims 11 through 15.

VI. ISSUES ((37 C.F.R. § 1.192(c)(6))

Broadly, whether claims 9-21 are unpatentable under 35 USC §251 as being an improper recapture of broadened claimed subject matter surrendered on the original application for patent from which this reissue application is based.

VII. GROUPING OF CLAIMS ((37 C.F.R. § 1.192(c)(6))

The appended claims 9-21 are considered as standing or falling together.

VIII. ARGUMENTS ((37 C.F.R. § 1.192(c)(6)) REJECTIONS UNDER 35 U.S.C. 251 (37 C.F.R. § 1.192(c)(8)(v))

A. Factual Background

1. Prosecution of Parent U.S. Patent Application No. 08/292,880

Pertinent to these rejections is the prosecution of the original U.S. Application No. 08/292,880 as the Examiner's position relies entirely upon the prosecution history of that application. That application was filed with one independent and five dependent claims. These claims are printed in their as filed form together with application claims 7 and 8 added by amendment in the attached X. Appendix.

Original parent application claim 1 was directed to "a magnetically-actuated coupler assembly for a model railroad car" comprising six features: (a) a drawbar, (b) a integral leaf spring extending from one end of the drawbar, (c) a coupler head secured to a second end of the drawbar, (d) a cantilever spring secured to the drawbar, proximal the coupler body, (e) a magnetically-actuated post pivotally secured to the drawbar and (f) a pivotally mounted coupler knuckle, pivotally secured to the second end of the drawbar to interact with the cantilever spring to urge the coupler knuckle to a closed or coupled position.

The remaining original application claims 2-6 were dependent with claims 2-5 depending directly from claim 1 and claim 6 depending from claim 4. Claim 4 was directed to "(t)he magnetically actuated coupler assembly of claim 1 wherein the coupler body contains a pair of stops which limit the movement of the coupler knuckle".

In the first Office Action (Paper 2 mailed 5/18/95), all six claims were rejected over 35 U.S.C. 112, second paragraph, for allegedly confusing language in claims 1, 5 and 6. In addition, claims 1-3 and 5 were rejected over the prior art. Claims 4 and 6 were indicated to be allowable over the prior art if rewritten to overcome the 112 rejection as to include all limitations of the base claim and any intervening claim.

In a responsive Amendment filed July 31, 1995, claim 1 was amended to overcome the 112 rejection and the prior art rejection. Claims 4-6 were amended to conform to antecedent references and new independent claim 7 and dependent claim 8 were presented for examination. On page 3 of the Amendment, Applicant stated:

(A)pplicant has added new claims 7 and 8 which correspond to previous Claims 4 and 6 which are rewritten to overcome the rejections under 35 U.S.C. Section 112 and to include the limitations of the base claim and the intervening claim. (Applicant recognizes that these claims may be cancelled if amended Claims 1 and 4 are allowed).

Applicant argued for the allowability of claim 1-3 and 5 over the prior art but concluded his remarks for allowability of the claims on page 7 with the further statement:

Notwithstanding, the applicant has added new Claims 7 and 8 which correspond to Claims 4 and 6 rewritten to overcome the rejections under 35 U.S.C. Section 112 and including all of the limitations of the base claim and any intervening claims.

On or about October 23, 1995, the Examiner initiated a telephone interview with the Applicant's former representative. According to the Examiner's summary of that Interview (Paper 5),

(The) Examiner initiated interview to suggest taking of allowable material in claims 4 and 6 so as to eliminate a repeat of the original rejection and new rejection based on the **exhibits filed with the protest**. Applicant agreed to the Examiner's suggestions. Other changes were to correct formalities in the claims, see examiner's amendment for agreed upon changes. [Emphasis added].

A third party had filed a protest in the application with prior art. Although the protest was not made of record, its receipt and the Examiner's consideration of its exhibits were expressly acknowledged by the Examiner in this interview summary.

The Examiner issued a contemporaneous Notice of Allowability (Paper No. 6B) with an Examiner's Amendment. The only changes made to either Claim 7 or 8 were to Claim 7. In line 11, the second occurrence of "the" was changed to --a pivotally mounted -- and, in line 16, "a" was changed to --the-- and "," was changed to --is--. These reflect only Section 112 problems with Claim 7.

The Examiner further expressly set forth a Statement of Reasons for Allowance:

The combination of all of the features claimed in Claim 7, in particular with the use of two stops on the coupling head for limiting the pivotal movement of the coupler knuckle against the spring, is not found nor suggested by any of the prior art of record, including the exhibits of the protest filed 10/10/95.

Any comments considered necessary by Applicant must be submitted no later than the payment of the Issue Fee and, to avoid processing delays, should preferably accompany the Issue Fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance". [original emphasis]

The two stops referred to in the first above quoted paragraph were the only elements set forth in original parent application claim 4, which was presented in independent form as parent application claim 7. No comments were filed by the Applicant. The parent patent issued in due course on April 23, 1996.

2. Prosecution of Present U.S. Reissue Application No. 08/999,730

This reissue application was filed December 24, 1997, well within two years of the April 23, 1996 grant date of parent U.S. Patent No. 5,509,546. This reissue application was filed with a Preliminary Amendment canceling parent claim 1 and presenting a new independent claim 6 and new dependent claims 7-8 for examination. Original patent claims 2-5 were amended to depend directly or indirectly from new application claim 6.

Generally speaking, new independent claim 6 differed from cancelled patent claim 1 in that a portion of paragraph "c" in cancelled patent claim 1, specifically, the requirement for "a pair of stops" in the coupler head, was removed. Furthermore, the cantilever spring (paragraph (d) in original patent claim 1) was supplemented to further state how the cantilever spring had a first portion which curved away from the coupler body and a first end which curved back

towards the coupler knuckle to apply a tangential force to the coupler knuckle. New reissue application dependent claims 7 and 8 recited specifically the molding of the cantilever spring and the cantilever spring and leaf spring, respectively, from engineering plastic.

A new independent claim 9 was further presented directed to a magnetically-actuated coupler assembly including a drawbar capable of being pivotally mounted within the coupler pocket of a model railroad car, a leaf spring integrally formed at one end of the drawbar, a coupler head formed at a second end of the drawbar and a cantilever spring integrally formed with and extending from the drawbar near the coupler head. It further called for a pivotable coupler knuckle secured to the head and a magnetically-actuated post to pivotably secure the coupler knuckle to the coupler head. Claim 9 further expressly recited that the cantilever spring has a first portion which curves away from the drawbar and a free end which curves back toward the coupler knuckle to apply a tangential force to the coupler knuckle. Claim 9 also eliminated the requirement for stops in the coupler head that were required in patent claim 1.

The Examiner issued a first action allowance of the claims 2-9 on December 21, 1998, stating:

The combination of all of the features of the independent claims, including the newly added limitations of the particular shape and orientation of the cantilever spring relative to the pivoting knuckle, is not found or suggested by the prior art of record.

After Applicant filed a Declaration As To Loss Of Patent in response to the 12/21/98 Notice of Allowance, the Examiner issued a second Notice of Allowance of the reissue application on May 6, 1999.

On December 16, 1999, the Examiner initiated a telephone interview to discuss certain informalities which he thought existed in the application. In response, Applicant filed a Supplemental Amendment After Allowance with a Petition for Late Entry of Amendment on January 7, 2000, to incorporate certain minor changes agreed upon between the Examiner and applicant's prior representative to clarify existing language in patent claim 5 and to correct a reference in reissue application claim 9 lacking proper antecedent basis. A third Notice of Allowance was issued on February 28, 2000. Payment of the Issue Fee was submitted in May, 2000.

On September 22, 2000, the Examiner withdrew the February 2000 Notice of Allowance on the grounds that the Reissue Oath/Declaration was defective and that claims 2-9 were being

rejected as being based upon a defective reissue declaration and also being an improper recapture of broadened claim subject matter surrendered in the original application for U.S. Patent 5,509,546. With respect to the latter, the Examiner asserted that "the combination of all of the features claimed in claim 7, in particular, with the use of two stops on the coupler head for limiting pivotal movement of the coupler knuckle against the spring" was part of the basis in the Examiner's allowance of the original claims in the parent U.S. Patent 5,509,546. The Examiner went on to state that:

Because the application was allowed based on these limitations, and because applicant did not disagree with the reasons for allowance set forth by the examiner, applicant acquiesced and effectively surrendered the broader coverage of no stops during the prosecution of the parent. Even though the claims were narrowed in another aspect, applicant still surrendered the right to broaden the claims by removing the limitations from the independent claims.

Claims 2-9 were indicated to be allowable over the prior art.

In response to the reopening of prosecution, the applicant filed on December 22, 2000, an Amendment which revised claims 6 and 9, and added new claims 10-21 for examination. More particularly, independent claim 6 and 9 were amended to include a requirement for a pair of stops as were essentially called for in originally granted patent claim 1. New independent claim 10 corresponded generally to independent claim 6 but deleted the express requirement for a leaf spring and added some further detail to the description of the cantilever spring which was claimed. It also expressly called for the pair of stops. New application claims 11-15 were restatements of dependent claims 2-5 and 7, respectively, but depended from new independent claim 10.

New independent claim 16 corresponded generally to claim 9 but again deleted the requirement for a leaf spring and added some different detail concerning the cantilever spring. It also required the pair of stops. Dependent claims 17-21 were essentially restatements of claims 2-5 and 7 but depend from new claim 16.

In the final Office Action mailed July 24, 2001, the Examiner indicated claims 2-8 were allowed while 9-21 were rejected under 35 U.S.C. §251 as being an improper recapture.

More specifically, the Examiner stated:

Specifically, the claims improperly remove limitations that the prosecution history of the parent application indicates were

essential to the allowance of the application. The reasons for allowance in the original applicant specifically state that the allowance of the application was because of “the combination of ***all of the features claimed in claim 7***, in particular, with the use of two stops on the coupling head for limiting pivotal movement of the coupler knuckle against the spring” (emphasis added). Because the application was allowed based on these limitations, and because applicant did not disagree with the reasons for allowance set forth by the examiner, applicant acquiesced and effectively surrendered broader coverage outside the scope of claim 7. Even though the claims were narrowed in another aspect, applicant still surrendered the right to broaden the claims beyond what the prosecution history indicated as being essential to patentability. It is suggested that the deleted material of claim 7 be reinstated in the independent claims to place the application in condition for allowance and eliminate the recapture.

Following that stated basis for rejection, the Examiner specifically indicated language that should be added to claims 9 through 21. That language has been added to claims 22-34, which the undersigned representative understands will be allowed if appeal claims 9-21 are rejected.

B. Legal Background

The recapture “rule” relied upon by the Examiner is a court created equitable doctrine. The Examiner has cited and relied upon three cases in support of his position: *Hester Industries, Inc. v. Stein, Inc.* 142 F.3d 14762, 46 USPQ2D 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); and *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984).

The requirements for a determination of when and how recapture is determined is best set forth in *In re Clements..* *In re Clement* states that the determination of recapture is a multi-step process. 45 USPQ2d 1161, 1164-65:

The first step in applying the recapture rule is to determine whether and in what “aspect” the reissue claims are broader than the patent claims. For example, a reissue claim that deletes a limitation or element from the patent claims is broader in that limitation’s aspect. ... Under *Mentor*, courts must determine in which aspects the reissue claim is broader, which includes broadening as a result of an omitted limitation. ...

The second step is to determine whether the broader aspects of the reissue claims relate to surrendered subject matter. To determine whether an applicant surrendered particular subject matter, we look to the prosecution history for arguments and changes to the claims

made in an effort to overcome a prior art rejection. *See Mentor* 998 F.2d at 995-96, 27 USPQ2d at 1524-25; *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 294-98 (Fed. Cir. 1984)

(T)he recapture rule does not apply in the absence of evidence that the applicant's amendment was "an admission that the scope of that claim was not in fact patentable," *Seattle Box Co. v. Industrial Crating & Packing, Inc.*, 731 F.2d 818, 826, 221 USPQ 568, 574 (Fed. Cir. 1984)

Once we determine that an applicant has surrendered the subject matter of the canceled or amended claim, we then determine whether the surrendered subject matter has crept into the reissue claim.

...

In both *Mentor* and *Ball*, the relevance of the prior art rejection to the aspects narrowed in the reissue claim was an important factor in our analysis. From the results and reasoning of those cases, the following principles flow: (1) if the reissue claim is as broad as or broader than the canceled or amended claim in all aspects, the recapture rule bars the claim; (2) if is narrower in all aspects, the recapture rule does not apply but other rejections are possible; (3) if the reissue claim is broader in some aspects, but narrower in others, then: (a) if the reissue claim is as broad as or broader in an aspect germane to prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim; (b) if the reissue claim is narrower in an aspect germane to prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim, but other rejections are possible. *Mentor* is an example of (3)(a); *Ball* is an example of (3)(b).

C. Detailed Argument

1. The Examiner's Position is Unsupported By Law

a. The cited cases do not support the Examiner's position.

While the three cases cited by the Examiner outline the parameters of the recapture doctrine, they provide no support for his particular application of that doctrine to reject claims 9-21 in the present application. None of the cited cases involves a case exactly like the present application where the claims in question were indicated to be allowable over the prior art in the first office action and never rejected over the prior art during the prosecution of the underlying patent. However, to the extent they support either party, they support applicant.

In *Ball*, the third case relied upon by the Examiner, the court found that the recapture rule did not apply in a case factually more closely related to the present application than either *Clement* or *Hester*. The latter pair of cases involved reissue of claims that were amended during prosecution to distinguish over prior art and which were allowed based upon such amendment and argument. In *Ball*, an independent application claim 7 and a dependent claim 8 were rejected in a first Office Action over the prior art while a dependent claim 9 was indicated to be allowable. Claim 8 called for “at least one” conductive lead while claim 9 required “a plurality of leads”. After the claims were amended in other ways, the Examiner repeated the rejection of claim 8 and suggested the allowability of the plurality of lead line claims if presented in independent form. The claims were again amended to require “a plurality of leads” and were subsequently allowed. *Ball*, 221 USPQ at 291.

In the reissue application of *Ball*, which was filed within two years of the grant of the original patent, the applicant presented new claims which eliminated the requirement for a “plurality of leads” and further eliminated a requirement in the broadest allowed patent claim that the antenna be of a cylindrical configuration. Despite these two broadening changes, the court still found that the granted reissue claims were sufficiently narrower than the cancelled claims to avoid the recapture rule. *Ball*, 221 USPQ at 292. Equally important as the broadening that was permitted in *Ball* is the fact that the court did not take the applicant’s decision to follow the Examiner’s suggestion to accept certain claims or subject matter as being allowable as evidence that the applicant had admitted the scope of the originally canceled claims were not patentable.

The cases cited by the Examiner simply do not support the application of the recapture rule in this application.

b. The Examiner’s position is further contrary to the Patent Rules.

The Examiner’s position is contrary to 37 C.F.R. 1.109 *Reasons for Allowance*. That Rule states:

If the Examiner believes that the record of the prosecution as a whole does not make clear his or her reasons for allowing the claim or claims, the Examiner set forth such reasoning. The reasons shall be incorporated into an Office action rejecting other claims... or be the subject of a separate communication to the applicant or patent owner. The applicant or patent owner may file a statement commenting on the reasons for allowance within such

time as may be specified by the Examiner. **Failure to file such a statement shall not give rise to any implication that the applicant or patent owner agrees with or acquiesces in the reasoning of the Examiner.** [Emphasis added.]

The only basis relied upon by the Examiner for acquiesce of Applicant to the Examiner's position on allowability of the claims is Applicant's lack of a response to the Examiner's stated reason for allowance. Under 37 C.F.R. 1.109 as quoted above, neither the Examiner nor the public can rely upon the Applicant's non-response to a stated reason for allowance as an acquiescence to the Examiner's reasoning. The Rule is explicit that the lack of a reply shall not give rise to any implication of agreement or acquiescence and that is precisely what the Examiner has done. Thus, the sole basis relied upon by the Examiner for evidence of applicant's agreement or acquiescence is expressly prohibited by rule, and therefore the issue of recapture is unsupported by law.

2. The Examiner's Position is Factually Unsupported on Numerous Grounds

a. The Applicant was Under no Obligation to Respond.

The Examiner asserts that Applicant was obligated to respond if Applicant disagreed with the Examiner's opinion. In fact, the Examiner gave Applicant the option to decide whether a response was necessary under the circumstances. The Examiner did not simply invite the Applicant to "submit any comments considered necessary." Unfortunately for the Examiner's primary argument now, the Examiner expressly invited the Applicant to submit "any comments considered necessary **by applicant...**" (Emphasis added.) The form of the Examiner's invitation makes applicant the sole determiner of what was considered necessary for response. The Examiner cannot now complain that the Examiner now thinks it was necessary that comments should have been made by the Applicant under the circumstances.

b. There Was No Reason For Applicant To Have Contested the Portion of the Examiner's Reason for Allowance Being Relied Upon By the Examiner Since It Was Nothing More Than A Statement of the Examiner's Obligation.

The portion of the Examiner Reason for Allowance that he relies upon for Applicant's acquiescence was, on the one hand, merely a factually correct statement of the law and his obligations and was therefore incontestable. The Examiner is expected to review all claims for allowability over the prior art under 35 USC §§ 102 and 103. Under MPEP 2141, the Examiner must consider "the claimed invention...as a whole." This means he must consider all of the

elements/features of the claims in determining patentability. Indeed, he is not permitted to consider anything less. Accordingly, the portion of the Examiner's statement of reason for allowance that he points to is truly nothing more than a restatement of his obligations under the statutes, the regulations and rules and the MPEP, which would not merit or warrant a response from the Applicant let alone a protest.

c. The File History Makes Clear That the Examiner Was Not Relying On “all of the elements of claim 7”, As Now Asserted, For Allowance of Claim 7 of the Parent Patent Application.

On the other hand, other facts in the file history make clear the true reason for the allowance of claim 7 in the parent patent application and the reason why the Examiner even proffered a statement for allowability of a claim that had never been rejected over the prior art.

The true reason for the Examiner's allowance of patent claim 1 is transparent from the file history and indeed from other portions of his statement of reason for allowance that he chooses to now ignore. The reason for the seeming irrelevance of the language the Examiner is relying upon is that it is taken out of context. What is more telling is the quoted portion of the reason for allowance he chooses now not to emphasize, namely “in particular with the use of two stops on the coupling head for limiting the pivotal movement of the coupling knuckle against the spring....” This is the express language of original application claim 4, which was never rejected over the prior art and for which Applicant never argued or had need to argue for patentability. In the parent patent application, the Examiner had found all of the features of original application claim 1 from which application claim 4 depended and repeatedly rejected application claim 1. He also allowed claim 4 in his first action and repeated his allowance of that claim and corresponding independent claim 7 in each subsequent action. He never referred to the features of claim 4, the pair of stops contained in the coupler body which limit movement of the coupler knuckle, as being found in any of the prior art of record. Indeed, it is clear from the file history that he was unable to find any art showing the claimed pair of stops in a coupler body or any coupler assembly or in any analogous art. The file history clearly discloses that the Examiner lacked any art showing stops and therefore was unable to reject any coupler claim calling for such stops.

The Examiner's current position that he relied upon all the elements of patent claim 1 to allow that claim is further undercut by his treatment of claims 9-21 being rejected in the present reissue application. He has allowed all of these claims over the prior art. If he had truly been

relying upon all the elements of patent claim 1 for the original allowance of that claim, he should have had prior art available that would cover any claim that was broader in any respect than patent claim 1. Clearly he did not and does not.

d. The File History Reveals That The Examiner Provided The Statement of Reason for Allowability For A Different Reason.

The Examiner would have this Board believe that the Statement of Reason for Allowance was added to the Notice of Allowance to warn Applicant that the Examiner was relying upon all of the elements of parent patent application claim 7 to allow that claim to become patent claim 1 and that the Applicant should have responded to that warning. However, it has been shown above that the portion of the Statement of Reason of Allowance that the Examiner relies upon is nothing more than a restatement of the legal requirements and his obligations for examination. This would seem to make the entire Statement a meaningless exercise. However, there is a portion of the Statement of Reason that is not *pro forma* and does explain why a Statement of Reason was even included. The end of the sentence that the Examiner now relies upon, which the Examiner does not rely upon or even quote, is that “The combination of...features...is not found nor suggested by any of the prior art of record, **including the exhibits of the protest filed 10/10/95.**”[Emphasis added.] A third party protest to the granting of a patent on this application was filed while the application was pending. It is nowhere reflected in the file history of this application before its acknowledgement by the Examiner here in the reasons for allowance and in the telephone interview summary. When considered as a whole, it is clear that the reason for the Examiner’s inclusion of a statement of the reasons for allowance was not to warn applicant that he (the Examiner) was relying upon all of the elements of application claims 4 and 7 for allowance but to give notice that he considered the patentability of claims against the prior art of the protest, neither expressly cited nor made of record in the application, and still found the claims, “in particular” with the feature of originally allowed claim 4, to be allowable over this art.

3. The Effect of Imposing the Recapture Rule On Applicant Under These Facts Constitutes A Denial of Equal Protection Under the Law

To allow the Examiner to now rely upon a statement of reasons for allowance and, in particular, a portion of that statement that merely recites what the Examiner is required under law to do in examining and allowing claims, denies applicant the rights under 35 USC §251 he would have otherwise been entitled to.

When Applicant's patent first issued, it was immediately endowed by law with a presumption of validity. That means it was legally presumed to have been examined and allowed according to law and to the rules and regulations relating to examination. It further means specifically that the Examiner is presumed to have considered each of the allowed claims as a whole and found them not to be obvious over the prior art.

Patentees whose applications are allowed without an express restatement of the law under which the Examiner must examine and allow claims are not required to file any statement contesting the allowance of their claims in order to preserve their right to seek a broadening reissue examination. If that were the case, there effectively would be no grounds ever for a broadening reissue. Denying applicant his statutory right under 35 U.S.C. 251 to a broadening reissue merely because the Examiner recites that he has done what he is supposed to do, denies applicant the same protection afforded patent owners whose examiners are not so "helpful". The failure to treat the present Applicant in the same way as patent owners whose patent claims are allowed without an express restatement of the criteria for allowance, is to treat patent owners unequally under the law in violation of Applicant's due process rights under the Fifth Amendment of the U.S. Constitution.

4. The Effect of Imposing the Recapture Rule On Applicant Under These Facts Is Inequitable.

The recapture rule is an equitable doctrine. The forgoing reasons of why this recapture is unsupported by law or fact also makes clear that it is not being applied equitably. There is certainly no equity in treating this applicant (and similarly situated applicants) differently from any other patentee who has his claims allowed without a restatement of the criteria for examination by the Examiner.

D. Summary

For the reasons set forth above, Applicant submits that the Examiner has failed to meet his burden of showing that the appealed claims 9-21 are invalid for any reason and further that there is no other basis anywhere in the record or under law or equity supporting the imposition of that rule to reject claims 9-21.

Accordingly the rejection of claims 9-21 must be REVERSED and claims 9-21 allowed.

IX.

APPENDIX OF CLAIMS INVOLVED IN THE APPEAL

9. A magnetically-actuated coupler assembly for a model railroad car comprising:
a drawbar capable of being pivotally mounted within a coupler pocket of a model railroad car, the drawbar including a first end having a leaf spring formed as an integral part thereof which extends from the first end of the drawbar, a coupler head formed on a second end of the drawbar, and a cantilever spring formed as an integral part of the drawbar extending from the drawbar adjacent to the coupler head;
a pivotable coupler knuckle secured to the coupler head; and
a magnetically-actuated post which pivotally secures the coupler knuckle to the coupler head, the magnetically-actuated post being pivotally connected to and extending downwardly from the coupler head, the coupler knuckle being in constant contact with the cantilever spring to urge the coupler knuckle to a closed or coupled position, the cantilever spring having a first portion which curves away from the drawbar and a free end which curves back toward the coupler knuckle to apply a tangential force to the coupler knuckle, such that the magnetically-actuated coupler is assembled from three parts and the coupler head containing a pair of stops which limit the movement of the pivotally mounted coupler knuckle.

10. A magnetically-actuated coupler assembly for a model railroad car comprising:

- (a) drawbar with first and second ends, the first end being configured for pivotal mounting within a coupler pocket of a model railroad car;
- (b) a coupler head at the second end of the drawbar,
- (c) a magnetically-actuated post pivotally secured to the drawbar so as to extend downward from the drawbar,
- (d) a coupler knuckle pivotally secured to the second end of the drawbar with the post, the coupler head having a pair of stops which limit the pivotal movement of the coupler knuckle on the drawbar, and
- (e) a cantilever spring formed as an integral part of the drawbar, the cantilever spring including a first portion extending from the drawbar proximally the coupler head which curves away from the drawbar and the coupler knuckle and a free end which curves back toward

the coupler knuckle sufficiently so as to constantly apply a tangential force against the coupler knuckle and urge the coupler knuckle to a closed or coupled position in all positions of the coupler knuckle between the pair of stops.

11. The magnetically-actuated coupler assembly of claim 10 further comprising a leaf spring secured to the first end of the drawbar and extending outward and around the first end of the drawbar to form a C-shape.

12. The magnetically-actuated coupler assembly of claim 10 wherein the outer tip of the coupler knuckle contains a lip which extends inward toward the post.

13. The magnetically-actuated coupler assembly of claim 10 wherein the drawbar includes an extension lip, extending from the drawbar.

14. The magnetically actuated coupler assembly of claim 10 wherein the coupler knuckle contains a slot, an edge of which interacts with one of the stops of the coupler head to limit the capability of the coupler knuckle to open.

15. The magnetically-actuated coupler knuckle of claim 10 wherein the cantilever spring and the drawbar are molded together as a unitary piece from engineering plastic.

16. A magnetically-actuated coupler assembly for a model railroad car comprising:

a drawbar having a first end adapted to be pivotally mounted within a coupler pocket of a model railroad car and an opposing, second end,

a coupler head formed on the second end of the drawbar,

a cantilever spring formed as an integral part of the drawbar extending from the drawbar adjacent to the coupler head;

a coupler knuckle pivotally secured to the coupler head; and

a magnetically-actuated post pivotally securing the coupler knuckle to the coupler head, the magnetically-actuated post being pivotally connected to and extending at least downwardly from the coupler head, the coupler knuckle being in constant contact with the cantilever spring to urge the coupler knuckle to a closed or coupled position, the cantilever spring having a first portion which curves away from the drawbar and a free end which curves back toward the coupler knuckle to apply a tangential force to the coupler knuckle, such that the magnetically-actuated coupler is assembled from three parts, and

the coupler head containing a pair of stops which limit the movement of the pivotally mounted coupler knuckle.

17. The magnetically-actuated coupler assembly of claim 16 further comprising a leaf spring secured to the first end of the drawbar and extends outward and around the first end of the drawbar to form a C-shape.

18. The magnetically-actuated coupler assembly of claim 16 wherein the outer tip of the coupler knuckle contains a lip which extends inward toward the post.

19. The magnetically-actuated coupler assembly of claim 16 wherein the drawbar includes an extension lip, extending from the drawbar.

20. The magnetically actuated coupler assembly of claim 16 wherein the coupler knuckle contains a slot, an edge of which interacts with one of the stops of the coupler head to limit the capability of the coupler knuckle to open.

21. The magnetically-actuated coupler knuckle of claim 17 wherein the cantilever spring and the drawbar are molded together as a unitary piece from engineering plastic.

X.

APPENDIX OF ORIGINAL CLAIMS

PROSECUTED IN PARENT APPLICATION 09/292,880

1. A magnetically-actuated coupler assembly for a model railroad car comprising
 - (a) a drawbar with first and second ends, pivotally mounted within a coupler pocket in the end of a model railroad car;
 - (b) secured to the first end of the drawbar is an integral leaf spring extending from the first end of the drawbar,
 - (c) secured to the second end of the drawbar is a coupler head;
 - (d) a cantilever spring secured to the drawbar proximal from the coupler body,
 - (e) a magnetically-actuated post pivotally secured to the drawbar which extends downward from the drawbar, and
 - (f) a pivotally mounted coupler knuckle, pivotally secured to the post and to the second end of the drawbar such that it interacts with the cantilever spring to urge the coupler knuckle to a closed or coupled position.
2. The magnetically-actuated coupler assembly of Claim 1 wherein the leaf spring is secured to the first end of the drawbar and extends outward and around the first end of the drawbar to form generally a C-shape.
3. The magnetically-actuated coupler assembly of Claim 1 wherein an outer tip of the coupler knuckle contains a lip which extends inward toward the post.
4. The magnetically actuated coupler assembly of Claim 1 wherein the coupler body contains a pair of stops which limit the movement of the coupler knuckle.
5. The magnetically actuated coupler assembly of Claim 1 wherein the coupler knuckle includes an extension lip, extending from the drawbar.
6. The magnetically-actuated coupler assembly of Claim 4 wherein the coupler knuckle contains a slot, an edge of which interacts with a stop of the coupler body to limit the capability of the coupler knuckle to open.
7. A magnetically-actuated coupler assembly for a model railroad car comprising

(a) a drawbar with first and second ends, capable of being pivotally mounted within a coupler pocket in the end of a model railroad car,

(b) formed as an integral part of the first end of the drawbar is a leaf spring extending from the first end of the drawbar,

(c) secured to the second end of the drawbar is a coupler head, wherein the coupler head contains a pair of stops which limit the movement of the coupler knuckle;

(d) a cantilever spring formed as an integral part of the drawbar located proximal from the coupler body,

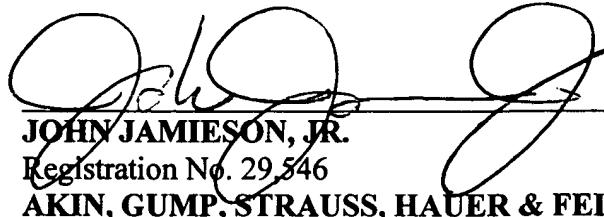
(e) a magnetically-actuated post pivotally secured to the drawbar which extends downward from the drawbar, and

(f) a pivotally mounted coupler knuckle, pivotally secured to the second end of the drawbar such that it is in constant interaction with the cantilever spring to urge the coupler knuckle to a closed or coupled position.

8. The magnetically actuated coupler assembly of Claim 7 wherein the coupler knuckle contains a slot, an edge of which interacts with one of the stops of the coupler head to limit the capability of the coupler knuckle to open.

Respectfully submitted,
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